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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,753

03/04/2004

Tsutomu Fujimura

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06/30/2006

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ALEXANDRIA, VA 22314

EXAMINER

LEITH, PATRICIA A

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,753

Applicant(s)

FUJIMURA, TSUTOMU

Examiner

Patricia Leith

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1655

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/18/06 has been entered.

The Examiner in this case has changed. Please note the new contact information provided at the end of this Office Action.

Claims 1-5 and 8-17 are pending in the application.

Claims 1-3 and 5 remain withdrawn from the merits as being directed toward a non-elected invention. It is noted that Applicant has deleted the elected species from the claims. Therefore, the Examiner has searched a new species on the merits: *Zizyphus jujuba*. The remainder of the species of plants pending in the claims remain withdrawn from the merits.

Claims 4 and 8-17 were examined on their merits.

Claim Objections

Claims 4 and 13 are objected to because of the following informalities:

Claim 4 recites ' wherein said agent comprises of a substance' which should properly read 'wherein said agent comprises a substance'. This is considered a minor typographical error.

Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 13 recites 'wherein said substance is a part of a plant'. 'A plant' is directed toward any plant, which is much broader in scope than claim 4. It is thought that Applicant means to limit claim 13 to a part of any one of said plants of claim 4, but the Examiner is not sure.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maor et al. (US 6,248,340 B1).

Applicant has cancelled the elected species from claim 4. Thus, the Examiner has searched another species on the merits; *Zizyphus jujuba*.

Maor et al. (US 6,248,340 B1) teaches the hydrosoluble (propylene glycol) extract of *Zizyphus jujuba* fruit for use in topical creams due to its 'emollient properties'.

Maor et al. did not specifically teach the amount of solids in the extract, the amount of cream applied to the skin nor did they teach the use of the entire fruit of *Z. jujuba*.

Generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such

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concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Variations of components in cosmetic compositions were well known in the art. One of ordinary skill in the art would have been motivated to have modified the proportions of solid ingredients in the cream disclosed by Maor et al. in order to optimize the texture of said cream. Such variations in cosmetic ingredients is considered routine optimization of result effective variables; conventional practice in the art of pharmacology. Further, one of ordinary skill in the art would be motivated to vary the amount applied to the skin in response to the condition of the skin; i.e., one would be motivated to apply a large amount of cream to the skin if the skin was very dry and cracked, and a lesser amount if the skin is less dry and cracked.

One of ordinary skill in the art would have been motivated to use the fruit of *Z. jujuba* in a concentrated or macerated form to apply to the skin because it was known that the fruit of *Z. jujuba* contained emulsifying properties. Thus, one of ordinary skill in the art would have had a reasonable expectation that the fruit of the plant would have been advantageous for use in a skin-care product such as a lotion or a cream. It is noted also that claims 13 and 8 limit claim 4 to wherein the substance is or comprises a 'part of the/a plant'. Maor et al. clearly make obvious these claims because the extract of *Z. jujuba* fruit would necessarily contain a 'part of' *Z. jujuba* fruit.

It is deemed that topical application of *Z. jujuba* fruit and/or extract would have intrinsically enhanced the expression level of Rho kinase or myosin light-chain kinase because these products are the same products described by the claims as well as the Specification (specifically, the Specification teaches that the propylene glycol extract of *Z. jujuba* (*inter alia*) contains the active ingredient which manifests the enhancement in the expression level of Rho kinase or myosin light-chain kinase – see page 10, Instant specification).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia Leith
Primary Examiner
Art Unit 1655

A handwritten signature in black ink, appearing to read 'Patricia Leith', written in a cursive style.

June 19, 2006